

S.N. 10/618,217
John Martin Moffatt
Atty Dkt 200208709-1

REMARKS

Claims 1-10 were pending in the application prior to this amendment. Claims 1, 7, 8 and 10 have been amended herein. Claim 9 has been canceled. Claims 2-6 remain in the application unchanged. Accordingly, after entry of this amendment, claims 1-8 and 10 will be pending in the application. Reexamination and reconsideration are requested.

S.N. 10/618,217
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Atty Dkt 200208709-1

**I. Legal Basis for Prior Art Claim Rejections Made in the Office
Action**

Legal Basis for Claim Rejection Under 35 U.S.C. §102

The standard for lack of novelty, that is, for "anticipation," under 35 U.S.C. 102 is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all its essential elements. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 90 (Fed. Cir. 1986).

Obviousness Under 35 U.S.C. §103

The test for obviousness under 35 U.S.C. 103 is whether the claimed invention would have been obvious to those skilled in the art in light of the knowledge made available by the reference or references. *In re Donovan*, 184 USPQ 414, 420, n. 3 (CCPA 1975). It requires consideration of the entirety of the disclosures of the references. *In re Rinehart*, 189 USPQ 143, 146 (CCPA 1976). All limitations of the Claims must be considered. *In re Boe*, 184 USPQ 38, 40 (CCPA 1974). In making a determination as to obviousness, the references must be read without benefit of applicants' teachings. *In re Meng*, 181 USPQ 94, 97 (CCPA 1974). In addition, the propriety of a Section 103 rejection is to be determined by whether the reference teachings appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination, or other modifications. *In re Lintner*, 173 USPQ 560, 562 (CCPA 1972).

In the case of *In re Wright*, 6 USPQ 2d 1959 (CAFC 1988), the CAFC decided that the Patent Office had improperly combined references which did not suggest the properties and results of the applicants' invention nor suggest the claimed combination as a solution to the problem which applicants'

S.N. 10/618,217
John Martin Moffatt
Atty Dkt 200208709-1

invention solved.

The CCPA reached this conclusion after an analysis of the prior case law, at p. 1961:

We repeat the mandate of 35 U.S.C. 103: it is the invention as a whole that must be considered in obviousness determinations. The invention as a whole embraces the structure, its properties, and the problem it solves. See, e.g., *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025, 226 USPQ 881, 886 (Fed. Cir. 1985) ("In evaluating obviousness, the hypothetical person of ordinary skill in the pertinent art is presumed to have the 'ability to select and utilize knowledge from other arts reasonably pertinent to [the] particular problem' to which the invention is directed"), quoting *In re Antle*, 444 F.2d 1168, 1171-72, 170 USPQ 285, 287-88 (CCPA 1971); *In re Antonie*, 559 F.2d 618, 619, 195 USPQ 6, 8 (CCPA 1977) ("In delineating the invention as a whole, we look not only in the claim in question... but also to those properties of the subject matter which are inherent in the subject matter and are disclosed in the specification") (emphasis in original).

The determination of whether a novel structure is or is not "obvious" requires cognizance of the properties of that structure and the problem which it solves, viewed in light of the teachings of the prior art. See, e.g., *In re Rinehart*, 531 F.2d 1048, 1054, 189 USPQ 143, 149 (CCPA 1976) (the particular problem facing the inventor must be considered in determining obviousness); see also *Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984) (it is error to focus "solely on the product created, rather than on the obviousness or notoriousness of its creation") (quoting *General Motors Corp. v. U.S. Int'l Trade Comm'n*, 687 F.2d 476, 483, 215 USPQ 484, 489 (CCPA 1982), cert. denied, 459 U.S. 1105 (1983)).

Thus the question is whether what the inventor did would have been obvious to one of ordinary skill in the art attempting to solve the problem upon which the inventor was working. *Rinehart*, 531 F.2d at 1054, 189 USPQ at 149; see also *In re Benno*, 768 F.2d 1340, 1345, 226 USPQ 683, 687 (Fed. Cir. 1985) ("appellant's problem" and the prior art present different problems requiring different solutions").

A basic mandate inherent in Section 103 is that a piecemeal

S.N. 10/618,217
John Martin Moffatt
Atty Dkt 200208709-1

reconstruction of prior art patents shall not be the basis for a holding of obviousness. It is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *In re Kamm*, 172 USPQ 298, 301-302 (CCPA 1972). Phrased somewhat differently, the fact that inventions of the references and of applicants may be directed to concepts for solving the same problem does not serve as a basis for arbitrarily choosing elements from references to attempt to fashion applicants' claimed invention. *In re Donovan*, 184 USPQ 414, 420 (CCPA 1975).

It is also clearly established in the case law that a change in the mode of operation of a device which renders that device inoperative for its stated utility as set forth in the cited reference renders the reference improper for use to support an obviousness-type rejection predicated on such a change. See, e.g., *Diamond International Corp. v. Walterhoefer*, 289 F.Supp. 550, 159 USPQ 452, 460-61 (D.Md. 1968); *Ex parte Weber*, 154 USPQ 491, 492 (Bd.App. 1967). In addition, any attempt to combine the teaching of one reference with that of another in such a manner as to render the invention of the first reference inoperative is not permissible. See, e.g., *Ex parte Hartmann*, 186 USPQ 366 (Bd.App. 1974); and *Ex parte Stemau*, 155 USPQ 733 (Bd.App. 1967).

A reference which teaches away from the applicants' invention may not properly be used in framing a 35 U.S.C. 103 rejection of applicants' claims. See *United States v. Adams*, 148 USPQ 429 (Sup. Ct. 1966).

S.N. 10/618,217
John Martin Moffatt
Atty Dkt 200208709-1

II. Rejection of Claims 1, 4-6 and 8-10 under 35 U.S.C. §102(b)

Claims 1, 4-6 and 10 stand rejected under 35 U.S.C. §102(b) as being anticipated by Younger (U.S. 3,856,388). Reexamination and reconsideration of the Examiner's rejection are requested.

Claims 1 and 4-6

Claim 1, as amended herein, recites the following:

A projector comprising:
a housing defining an interior and an exterior;
a first projection path extending from said interior to a first surface on said exterior;
a second projection path extending from said interior to a second surface on said exterior;
a light source positioned in said interior, said light source capable of creating a first image on said first surface and a second image on said second surface ~~a visual~~;
wherein said first projection path is aligned with said light source; and
wherein said second projection path is aligned with said light source; and
wherein, said first image is larger than said second image.

Claim 1 has been amended herein, as indicated above, to recite a first image formed on a first surface, a second image formed on a second surface and that the first image is larger than said second image. This language is fully supported by applicant's originally-filed application with reference, for example, to drawing Fig. 1 (note first image 24 and second image 28). No

S.N. 10/618,217
John Martin Moffatt
Atty Dkt 200208709-1

new matter has been added.

With reference, for example, to Figs. 4 and 5 of the Younger reference, it can be appreciated that all of the images formed by the Younger projection house 42 are of the same size. Accordingly, claim 1, as amended herein, is not anticipated by Younger.

Claims 4-6 are allowable at least as depending from allowable base claim 1.

Claims 8 and 9

Independent claim 8, as amended herein, recites the following:

A method for presenting a visual, said method comprising:
generating a first visual emitted from a projector along a first projection path;
generating a second visual emitted from said projector along a second projection path;
projecting said first visual onto a first wall causing a first image to be formed on said first wall; and
projecting said second visual onto a second wall causing a second image to be formed on said second wall; and
wherein, said first image is larger than said second image.

Claim 8 has been amended, as indicated above, in a manner similar to claim 1. Accordingly, claim 8 is allowable for at least the reasons advanced above with respect to claim 1. Claim 9 has been canceled.

S.N. 10/618,217
John Martin Moffatt
Atty Dkt 200208709-1

Claim 10

Independent claim 10, as amended herein, recites the following:

An apparatus comprising:

a means for projecting at least a first image and a second image
~~one image~~;

a first projection path extending from said means for projecting;
and

a second projection path extending from said means for
projecting, said second projection path being directed in a direction
different than said first projection path; and

wherein said first image is larger than said second image.

Claim 10 has been amended, as indicated above, in a manner similar
to claim 1. Accordingly, claim 10 is allowable for at least the reasons
advanced above with respect to claim 1.

S.N. 10/618,217
John Martin Moffatt
Atty Dkt 200208709-1

III. Rejection of Claims 1-5 and 8-10 under 35 U.S.C. §102(b)

Claims 1-5 and 8-10 stand rejected under 35 U.S.C. §102(b) as being anticipated by Lindenberg (U.S. 2,041,194). Reexamination and reconsideration of the Examiner's rejection are requested.

Claims 1-5

Claim 1, as amended herein, recites the following:

A projector comprising:
a housing defining an interior and an exterior;
a first projection path extending from said interior to a first surface on said exterior;
a second projection path extending from said interior to a second surface on said exterior;
a light source positioned in said interior, said light source capable of creating a first image on said first surface and a second image on said second surface a visual;
wherein said first projection path is aligned with said light source; and
wherein said second projection path is aligned with said light source; and
wherein, said first image is larger than said second image.

Claim 1 has been amended herein, as indicated above, to recite a first image formed on a first surface, a second image formed on a second surface and that the first image is larger than said second image. As noted previously, this language is fully supported by applicant's originally-filed application. No new matter has been added.

S.N. 10/618,217
John Martin Moffatt
Atty Dkt 200208709-1

With reference, for example, to Fig. 1 of the Lindenberg reference, it can be appreciated that both of the images formed by the Lindenberg projector 13 are of the same size. Accordingly, claim 1, as amended herein, is not anticipated by Lindenberg.

Claims 2-5 are allowable at least as depending from allowable base claim 1.

Claims 8 and 9

Independent claim 8, as amended herein, recites the following:

A method for presenting a visual, said method comprising:
generating a first visual emitted from a projector along a first projection path;
generating a second visual emitted from said projector along a second projection path;
projecting said first visual onto a first wall causing a first image to be formed on said first wall; and
projecting said second visual onto a second wall causing a second image to be formed on said second wall; and
wherein, said first image is larger than said second image.

Claim 8 has been amended, as indicated above, in a manner similar to claim 1. Accordingly, claim 8 is allowable for at least the reasons advanced above with respect to claim 1. Claim 9 has been canceled.

S.N. 10/618,217
John Martin Moffatt
Atty Dkt 200208709-1

Claim 10

Independent claim 10, as amended herein, recites the following:

An apparatus comprising:
a means for projecting at least a first image and a second image
~~one image~~;
a first projection path extending from said means for projecting;
and
a second projection path extending from said means for
projecting, said second projection path being directed in a direction
different than said first projection path; and
wherein said first image is larger than said second image.

Claim 10 has been amended, as indicated above, in a manner similar
to claim 1. Accordingly, claim 10 is allowable for at least the reasons
advanced above with respect to claim 1.

S.N. 10/618,217
John Martin Moffatt
Atty Dkt 200208709-1

IV. Rejection of Claim 7 Under 35 U.S.C. §103(a) over Younger in view of Muehlhoff

Claim 7 stands under 35 U.S.C. §103(a) as being unpatentable over Younger (U.S. 3,856,388) in view of Muehlhoff (U.S. 6,773,113).

Reexamination and reconsideration of the Examiner's rejection are requested.

Claim 7 is allowable at least as depending from allowable base claim

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S.N. 10/818,217
John Martin Moffatt
Atty Dkt 200208709-1

V. Rejection of Claim 7 Under 35 U.S.C. §103(a) over Lindenberg in view of Muehlhoff

Claim 7 stands under 35 U.S.C. §103(a) as being unpatentable over Lindenberg (U.S. 2,041,194) in view of Muehlhoff (U.S. 6,773,113). Reexamination and reconsideration of the Examiner's rejection are requested.

Claim 7 is allowable at least as depending from allowable base claim

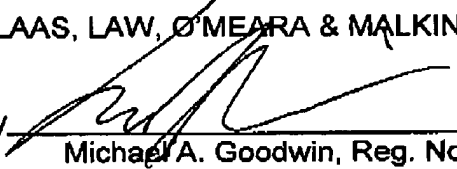
1.

In view of the above, all of the claims are now believed to be in condition for allowance. Re-examination and reconsideration are requested.

Respectfully submitted,

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Date: January 21, 2005

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